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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,623	12/08/2003	Srinivasulu Puri	021756-005300US	8904

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EXAMINER
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CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
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2136

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/731,623	Applicant(s) PURI ET AL.	
	Examiner David G. Cervetti	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/8/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-24 are pending and have been examined. Preliminary amendment and arguments filed December 8, 2003 have been considered.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: the reference to application numbers provided in page 1 needs to be updated to reflect applications that have matured into patents. Appropriate correction is required.

#### ***Claim Objections***

3. Claim 6 is objected to because of the following informalities: "electronic comprises", perhaps "electronic record comprises" was intended. Appropriate correction is required.

4. Claims 7, 8, 16, 17, 23, and 24 are objected to because of the following informalities: "XML" must be spelled out. Appropriate correction is required.

#### ***Double Patenting***

5. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. **10/731,299**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the triggering found in the instant application is analogous to the event of the copending one and both use such trigger to determine whether a digital signature is needed to perform a transaction (commit).

6. Claims 1-25 of copending Application No. **10/731,299** contain every element of claims 1-24 of the instant application and thus anticipate the claims of the instant application. Claims 1-24 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

7. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. **10/731,655**. Although the conflicting claims are not identical, they are not patentably distinct from each other because both use a trigger to determine whether a digital signature is needed to perform a transaction (commit).

8. Claims 1-26 of copending Application No. **10/731,655** contain every element of claims 1-24 of the instant application and thus anticipate the claims of the instant application. Claims 1-24 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

9. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of

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obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species with that genus). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

10. "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic claim. *In re Van Ornum*, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); *Schneller*, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (*In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993)

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 20-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 20-24 state "computer program stored on a computer-readable storage medium, the computer program comprising code for...", "computer program comprising code for" is considered non-statutory subject matter since it may comprise a code listing.

13. To expedite a complete examination of the application, the claims rejected under 35 U.S.C. 101 (non-statutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**15. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by SmartTeam (NPL “SmarTeam™ FDA Compliance Technical Paper Functional Compliance With FDA Rule 21 CFR Part 11”).**

Regarding claims 1 and 20, SmartTeam teaches a method of intercepting a transaction instantiated by a database application to determine if an electronic signature is necessary to commit the transaction to the database, the method comprising / A computer program stored on a computer-readable storage medium (**sections 1 – introduction - , 2.2-2.3**), the computer program comprising:

- in response to a triggering action generated by the database application, calling an application program interface to raise an event (**sec. 2.2**);
- initiating a workflow process that executes a rule to determine if an electronic signature is required to approve the transaction (**sec. 2.2**); and

- if execution of the rule results in a determination that an electronic signature is required for the transaction, instantiating a signature collection process (**sec. 2.2-2.3**).

**Regarding claim 11**, SmartTeam teaches a computer system (**sec. 2.1**)

comprising:

- a processor; a database; and a computer-readable memory coupled to the processor, the computer-readable memory configured to store a computer program (**sec. 2.1**);
- wherein the processor is operative with the computer program to:
  - o (i) call an application program interface to raise an event in response to a triggering action generated by the database application (**sec. 2.2**);
  - o (ii) initiate a workflow process that executes a rule to determine if an electronic signature is required to approve the transaction (**sec. 2.2**); and
  - o (iii) instantiate a signature collection process if execution of the rule results in a determination that an electronic signature is required for the transaction (**sec. 2.2-2.3**).

**Regarding claims 2 and 12**, SmartTeam teaches wherein the application program interface comprises an event name and an event id (**sec. 2.2-2.3**).

**Regarding claims 3 and 13**, SmartTeam teaches wherein the signature collection process can be either a synchronous collection process or an asynchronous collection process (**sec. 2.2, 2.4**).

**Regarding claim 4**, SmartTeam teaches wherein the application program interface comprises an event name, an event id and an indication of whether the signature collection process is a synchronous process or an asynchronous process (**sec. 2.2-2.4**).

**Regarding claims 5, 14, and 21**, SmartTeam teaches wherein the workflow process generates an electronic record that captures data associated with the transaction (**sec. 2.2**).

**Regarding claims 6, 15, and 22**, SmartTeam teaches wherein the electronic record comprises unstructured data (**sec. 2.1**).

**Regarding claims 7, 16, and 23**, SmartTeam teaches wherein the unstructured data comprises XML data stored in character large object (CLOB) format (**sec. 2.1**).

**Regarding claims 8, 17, and 24**, SmartTeam teaches wherein the XML data comprises a first well-formed XML document that comprises XML fields generated from a mapping to fields in a database and a second well-formed XML document that comprises the electronic record as it is displayed to a user during the signature collection process (**sec. 2.2-2.4**).

**Regarding claims 9 and 18**, SmartTeam teaches obtaining an electronic signature in response to the signature collection process; and thereafter, verifying the electronic signature and, if the electronic signature is verified, updating a field of the electronic record to indicate a valid signature was received (**sec. 2.2-2.3**).

**Regarding claims 10 and 19**, SmartTeam teaches committing the transaction to the database if the electronic signature is verified (**sec. 2.2**).



***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. NPLs provided teach using XML and digital signatures to provide for audit trail in a database system, Gladney (US Patent Application Publication 2003/0131241) teaches digital document interchange using digital signatures and binding signatures to data object when updates occur, Markowitz et al. (US Patent Application Publication 2003/0009295) teaches a laboratory information management system using XML and digital signatures, Kung (US Patent Application Publication 2003/0196108) teaches binding information objects to security labels, XML, and audit system.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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